PATENT

Paper No.

File: PKT-P1-06

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor	:	CROCKER, Greg H.
Serial No.	:	10/575,995
International Application No.	:	PCT/US05/20784
International Filing Date	:	June 13, 2005
For	:	COMPUTER SUPPORT FOR MORTGAGE LOCK OPTION
Group Art Unit	:	3691
Examiner	:	CAMPEN, Kelly Scaggs

MS: Fee Petition
Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO VACATE RESTRICTION / LACK OF UNITY

S I R :

The above-referenced patent application is a U.S. National patent application based on PCT/US2005/020784, wherein the PCT found unity of invention in its Decision. In an Office Action mailed 05/29/08, the Examiner issued a restriction requirement pursuant to 35 U.S.C. Secs. 121 and 372 based on PCT Rules 13.1 and 13.2. The Examiner thusly contended that there were 8 Groups of claims. In the amendment and response filed on 12/1/08, Applicant elected Group I (claims 1-16) with traverse and requested reconsideration. In particular, Applicant disputed the notion of a Sec. 121 restriction based on lack of unity in the US national case, traversed the restriction, and in any case, traversed the lack of unity holding. The Examiner maintained his restriction in

the Office Action of 02/18/09, and this is a petition from the restriction based on lack of unity.

The Examiner's contentions are set out in the office actions of 05/29/08 and 02/18/09.

First, a restriction requirement based on lack of unity is improper: 35 U.S.C. Secs. 121 and 372 do not provide for a restriction requirement based on lack of unity, as was done in the office actions of 05/29/08 and 02/18/09.

Second, with respect to the restriction requirement portion of the "restriction / lack of unity requirement" made pursuant to 35 U.S.C. Sec. 121, this statute requires a showing of "separate and distinct." The restriction requirement in the instant case is defective for failing to even allege "separate and distinct", let alone establish it. Nor does the Office Action set out a showing of any burden on the Examiner. Thus, the Examiner has not made out a prima facie case for a restriction requirement under Sec. 121. Indeed, the restriction requirement is defective for noncompliance with MPEP Sec. 806.05(d), which requires "restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search." The instant restriction requirement fails to even set out the class and subclass, and no contention is made with respect to a "serious burden" in the restriction requirement.

It is not even clear from the restriction requirement whether restriction is based on genus/species, combination/subcombination, or otherwise. Thus the showing and analysis respectively required with each of these kinds of restriction is completely lacking.

In sum, the restriction requirement made out pursuant to Sec. 121 fails to make out a prima facie case and is defective for the reasons set forth above. Indeed, the Office Action is so unclear and lacking in required *information* as to the nature of the restriction requirement that

that a fair response cannot be made, and thus the restriction requirement is also is improper pursuant to Rule 104 and 35 U.S.C. Sec. 132.

Third, in the event that this Petition turns on a PTO holding of lack of unity in a US application, it is respectfully submitted that a lack of unity has not even been shown.

The lack of unity holding is defective because it is all premised on differences among claims, rather than on whether there is a single general inventive concept.

Not that it is Applicant's burden under the circumstances of this restriction / lack of unity requirement to establish unity, but with regard to groups III-VIII, the Examiner acknowledges a common technical feature. In the initial restriction requirement of 05/29/08, the Examiner contends that Groups III-VII pertain to "a future lock-triggering price", and if the claims are viewed more comprehensively, the corresponding claims pertain to lock-triggering price computing with respect to one or more loans, which appears to be sufficient for unity of invention for these groups.

As to group I, the claims also pertains to computing with respect to evaluating the trigger for an option on a loan, and dependent claim 3 provides for the lock. Thus, the Examiner has not shown that there is no unity with respect to groups I, III-VIII.

And as to group II, there is computing with respect to an indicator of loan application status, which by dependent claims 18 and 20, includes an option status. Thus, the Examiner has not shown that there is no unity with respect to the respective groups, according to PCT rules.

The Examiner's reasoning, as best as it is understood in view of the inapposite notions of applying PCT rules under Sec. 121, seems to be that the common features lack inventive step or novelty. If this be the contention, then now after examination both in the US and PCT, no cited art seems to negate the existence of the technical features for unity. The Final Rejection notes, at page 5, that "option on a loan" is not used in the cited art, and Applicant

submits that there is no basis for a Sec. 102 rejection. And Applicant also submits that there is no basis for §103 rejection, and the final rejection is being appealed for reasons set out in Applicant's response, given the claim terminology as properly interpreted.

Under the PCT, it is believed that the determination of unity of invention is made on the contents of the claims as interpreted in light of the description and drawings (if any). This has not been done in the restriction / lack of novelty requirement.

Additionally, it is believed that under the PCT, the general inventive concept can be evident indirectly, i.e. the form of the invention claimed takes advantage of, or relies on, the general concept. This has not been shown in the restriction / lack of novelty requirement.

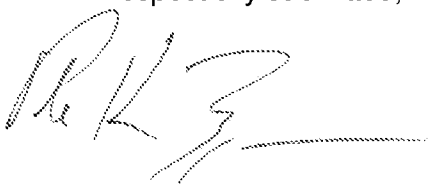
Applicant respectfully submits, consistent with the PCT Written Opinion, that a lack of unity of invention has not been shown. Unity exists not on the Examiner's selection of differences between claims, but instead on a general inventive concept under the PCT, as elucidated above. With this in mind, attention is respectfully drawn to certain computer-related operations pertaining to a loan in connection with an option, trigger, lock, or the like, as set forth in the claims, each as a whole.

In sum, for the reasons set forth above, the restriction / lack of unity requirement is believed to be improper under both Sec. 121 and under the PCT. Accordingly, Applicant respectfully requests that the claims of all groups, or any of the groups, be rejoined.

The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235. Additionally, the Examiner is invited to contact the undersigned at (312) 240-0824 if it can in any way expedite or ease the handling of this case.

Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,



Date: June 14, 2010

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